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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|-------------------------------|------------------|
| 10/724,025 | 11/26/2003 | Christopher A. Pawlik | 02-40199-US | 7268 |
| 7066 | 7590 | 10/19/2006 | | |
| REED SMITH LLP 2500 ONE LIBERTY PLACE 1650 MARKET STREET PHILADELPHIA, PA 19103 | | | EXAMINER GRAY, LINDA LAMEY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1734 | |

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,025

Applicant(s)

PAWLIK ET AL.

Examiner

Linda L. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claim Rejections - 35 USC 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartner et al. (US 5,284,363).

Claim 1, Gartner et al. teach apparatus 8, for example, the apparatus shown in Figures 5A and 5B. The apparatus includes first and second substantially planar members 20 and 10/40, respectively, which are releasably adhered to each other in a peelable and resealable fashion (c 5, L 48, to c 6, L 16; c 3, L 51, to c 4, L 31). Gartner et al. teach that the apparatuses in the patent may include one predefined tearing region 39 within the edges of both members 20 and 10/40 (Fig 1) where region 39 includes perforations and is suitable for being partially and/or torn fully (c 4, L 31-37). With respect to the intended use limitations of "for labeling a roll of product" and "to access a corresponding portion of the product when the apparatus is secured about the roll", apparatus 8 is considered capable of performing this intended use in that apparatus 8 could be placed as a label on a roll product such as a cylindrical container. Also, if region 39 were torn, a portion of the product (i.e., cylindrical container) could be accessed at the same portion through member 20 since such is made of plastic and therefore the product could be visible therethrough when member 20 is transparent.

Claims 2-3, apparatus 8 of Gartner et al. is capable of performing these further limited intended use limitations in that cylindrical containers such as pharmaceutical

bottles houses substrates (i.e., pills for example) (**claim 2**) which are sometimes individually wrapped in foil (**claim 3**) where apparatus 8 is capable of being applied to such products. **Claim 4**, apparatus 8 of Gartner et al. is capable of performing this further limited intended use limitation in that such products have initial vertical lengths from the bottom of the neck to the bottom of product where members 20 and 101/40 have a vertical width which could approximate to this length. **Claim 5**, apparatus 8 of Gartner et al. is capable of performing this further limited intended use limitation in that such products have an given perimetrical circumference where members 20 and 10/40 have a height (length around the product) which could approximate this circumference. **Claim 6**, members 20 and 10/40 each include first and second: first surfaces 22 and 28 with second surfaces 33 and 45. Surfaces 22, 33, 28, and 45 include visible indicia 18. **Claim 7**, a portion of surface 22 includes adhesive 25 thereon. **Claim 8**, the adhesive on surface 22 is capable of performing this further limited intended use limitation in that adhesive 22 adheres would be used to adhered apparatus 8 to the product.

3. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Bernier et al. (US 6,637,775 B1).

Claim 1, Bernier et al. teach apparatus 10 including first and second substantially planar members 14 and 12, respectively, releasably adhered to each other in a peelable and resealable fashion (c 2, L 53, c 3, L 49). Bernier et al. teach one predefined tearing region 42 within the edges of both members 14 and 12 (Fig 3) where region 42 includes perforations and is suitable for being partially and/or torn fully (c 3, L 40-49). With respect to the intended use limitations of "for labeling a roll of product" and "to access a corresponding portion of the product when the apparatus is secured about the roll", it is noted Bernier et al. teach that apparatus 10 is for labeling a roll product 11 (i.e., roll shaped bottles 11; c 2, L 52-55) with member 14 closest to product 11. Also, when region 42 is torn, one can access a corresponding portion of product 11 when apparatus 10 is secured about product 11 in that member 14 is

opaque and thus product 11 is visible (accessible) to a degree thereunder (c 3, L 50-56).

Claims 2-3, apparatus 10 of Bernier et al. is capable of performing these further limited intended use limitations in that product 11 houses substrates (i.e., pills for example) (**claim 2**) which are sometimes individually wrapped in foil (**claim 3**). **Claim 4**, apparatus 10 of Bernier et al. is capable of performing this further limited intended use limitation in that Figure 1 of Bernier et al. demonstrates product 11 to have an initial vertical length from the bottom of the neck to the bottom of product 11 where members 14 and 12 have a vertical width approximately equal to this length. **Claim 5**, apparatus 10 of Bernier et al. is capable of performing this further limited intended use limitation in that Figure 1 of Bernier et al. demonstrates product 11 to have an given perimetrical circumference where members 12 and 14 have a height (length around product 11) approximately equal to this circumference. **Claim 6**, members 14 and 12 each include first and second surfaces: first top surface 20 and second bottom surface 22 of member 14; first top surface 16 and second bottom surface 18 of member 12. Surfaces 16, 18, and 20 have visible indicia 24, 26, and 30 thereon. **Claim 7**, surface 22 includes an adhesive. **Claim 8**, the adhesive on surface 22 is capable of performing this further limited intended use limitation in that adhesive 22 adheres apparatus 10 to product 11.

Claim Rejections - 35 USC 103

4. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al.

Claim 9, Bernier et al. do not teach member 10/40 to be smaller than member 20.

The relative sizes members 10/40 and 20 is a result-effective variable in that changes in size effect the appearance of apparatus 8, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Gartner et al. an optimization of the relative size of member 10/40 compared to the that of member 20 for optimal appearance of apparatus 8.

Claim 10, surface 45 includes an adhesive thereon which is deadened in inner portions 38a (**claim 11**). **Claim 13**, member 10/40 includes an outer edge where the deadening is adjacent the edge (**claim 14**).

Claims 12 and 15, Bernier et al. do not teach deadening 30%-50% and 5% of the edge.

MPEP 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955). In this case, the range is the range percent of deadening. Also, the degree of deadening is a result-effective variable which effects the degree of releasability between members 10/40 and 20. Based upon this line of reasoning, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Gartner et al. an optimization of the percent of deadening for optimal release and reseal.

5. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernier et al.

Claim 9, Bernier et al. do not teach member 12 to be smaller than member 14.

The relative sizes members 12 and 14 is a result-effective variable in that changes in size effect the appearance of apparatus 10, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Bernier et al. an optimization of the relative size of member 12 compared to the that of member 14 for optimal appearance of apparatus 8.

Claim 10, surface 18 includes an adhesive thereon which is deadened in inner portions (**claim 11**). **Claim 13**, member 12 includes an outer edge where the deadening is adjacent the edge next to adhesive areas 50 (**claim 14**).

Claims 12 and 15, Bernier et al. do not teach deadening 30%-50% and 5% of the edge.

MPEP 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955). In this case, the range is the range percent of deadening. Also, the degree of deadening is a result-effective variable which effects the degree of releasability between members 12 and 14. Based upon this line of reasoning, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Bernier et al. an optimization of the percent of deadening for optimal release and reseal.

Response

6. Applicant's comments filed 9-26-06 have been fully considered. Applicant indicates that Gartner does not teach that layer 20, which is permanently adhered to the container, contains a tearing region as recited in claim 1: at least one predefined tearing region within the first and second substantially planar members.

In response, Gartner teaches that apparatus 8 includes at least one predefined tearing region 39 within the edges of both planar members 20 and 10/40. Specifically, region 39 is cut into the material of member 10/40 within its edges, and although region 39 is not cut into member 20, region 39 of member 10/40 is within the edges (outer perimeter) of member 20 -- thus the use of "one predefined tearing region 39 "within the edges" of both members 20 and 10/40" in the Office action on page 2, paragraph 2. The same applies to Bernier, paragraph 3 of the Office action in the sentence including "within the edges". Claim 1 could be amended to overcome Gartner and Bernier by language like or similar to the following: that the material of the first member includes at least one predefined tearing region, that the material of the second member includes at least one tearing corresponding to the at least one tearing regions of the first member, which the examiner could search. Gartner and Bernier do not teach that the second members includes the structural limitation the material itself including a tearing region.

Gartner and Bernier each teach that tearing region 39 is suitable for being at least partially torn as required in claim 1, last two lines. The other claim limitation of claim 1 of "to access a corresponding portion of the product when the apparatus is secured about the roll" refers to an intended use of the claimed product or apparatus, see the prior Office action at page 6, paragraph 6, subparagraph 6 beginning "In response, apparatus 8 of Gartner et al. . . .". Also, it is noted "to access" does not necessarily require that the portions of the product be removable (see lines 1-2, pg 8, of Applicant's response). "to access" is broad to include the ability to visibly view the product (i.e., "to access"), i.e., visibly view the bottle under the apparatus through the second members in Gartner and Bernier which are transparent.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public Pair. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).

llg

October 16, 2006




LINDA GRAY
PRIMARY EXAMINER